



UNITED STATES PATENT AND TRADEMARK OFFICE

W
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,271	02/28/2000	Raymond Senez	1782-014-999	9338

20583 7590 06/12/2003

PENNIE AND EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 100362711

EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
----------	--------------

3624

DATE MAILED: 06/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/514,271

Applicant(s)

SENEZ, RAYMOND

Examiner

JAGDISH N PATEL

Art Unit

3624

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 26 March 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

4) Claim(s) 1-26 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-26 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

4) Interview Summary (PTO-413) Paper No(s) _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

1. This communication is in response to amendment filed 3/26/03.

Response to Amendment

2. Specification has been amended per request. Claims 10 and 23 have been amended per request.

Response to Arguments

3. Applicant's arguments, with respect to prior rejection of claims 1-26 have been fully considered and are persuasive. Accordingly, rejection of claims 1-26 has been withdrawn.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2)

Art Unit: 3624

voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1,3,8,11,12,14,16,21 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Kitchen et al. (US Pat. 6,289,322) (hereafter Kitchen)

Claim 1: Kitchen discloses a system for the automated payment of bills comprising:

- (a) a bill processing server connected to a network (CF Station, Fig. 2, network 100);
- (b) one or more financial institution servers connected to said network, wherein a client has at least one banking account associated with at least one of said one or more financial institution servers and a biller has at least one banking account associated with at least one of said one or more financial institution servers (FI station 130a-c, Fig. 2, col. 8 L 46-55, refer to checking accounts maintained by ..payors, and deposit accounts maintained by billers, FI stations also connected to network 100);
- (c) one or more biller servers connected to said network, wherein said client has at least one billing account associated with at least one of said one or more biller servers (Biller stations 110a-d, since billers are service providers and merchants issuing bills to clients (payors) billing account of client is inherent);
- (d) at least one client computer connected to said network (Payor station 120a-d);

Art Unit: 3624

wherein said one or more biller servers includes means to format bill information and bill payment instructions associated with said at least one billing account (col. 6 L 29- col. 7 L 5 formatted billing information is provided to the CF station by the respective biller, this information is required in order that billing information be presented in the same form "as has been provided to the client in hard copy");

and wherein said bill information further includes means for initiating bill payment instructions (detailed billing information ..terms and conditions, col. 7 L 1-5, Fig. 2B and col. 8 L 56-67, payment instruction);

and wherein said at least one client computer comprises a processor, communication means, a server access program and a display for receiving and viewing from said one or more biller servers said bill information, and input means for selecting said means for initiating bill payment instructions (col. 7 L 36-51 "exemplary payor station");

and wherein said processor integral to said at least one client computer is responsive to said input means and causes said communication means to communicate said bill payment instructions to said bill processing server when said means for initiating bill payment instructions is selected (col. 7 L 37-60, A network interface (NI) 455 interconnects the payor station 120 to the network 100..., Messages transmitted by the CF station 140 to the payor station 120 are received via the network interface 455 and processed..request the available billing related information from the CF station);

and wherein said bill processing server causes a selected one of said at least one client banking account to be debited and a selected one of said at least one biller banking account

Art Unit: 3624

to be credited, upon receipt of said bill payment instructions (col. 8 L 46-67, ..the payment instructions are received and processed by the processor 410 of the CF station 140. ..the processor..directs the payment of the applicable bills ..by electronic funds transfer, col. 9 L 1-15, CF processor generates electronic funds transfer instructions);

and wherein said bill processing server reports to a selected one of said one or more biller servers a selected one of said at least one billing account associated with said biller and a credit amount (col. 9 L 15-29, remittance advice information..directly to the biller station 110a-110d..);

and wherein said bill processing server reports to a selected one of said at least one client computer a selected one of said at least one billing account associated with said client and a debit amount (refer to Fig. 13 status (1335)).

Claim 3. The system of claim 1 wherein information identifying said client and said biller banking accounts are stored in said bill processing server (refer to memory 420 which stores in area 420a biller data and in area 420b payor data including their respective account numbers).

Claim 8. The system of claim 1 wherein said means to communicate bill payment instructions is an icon (col. 13 L 64- col. 14 L 3).

Claim 11. bill payment instructions include a payment amount, a billing account number, an invoice number and a biller identification number (refer to Fig. 11 in view of icon 1120).

Claim 12. The system of claim 1 wherein said at least one client computer is a workstation, laptop, or wireless personal digital assistant (col. 7 L 18-35).

System claims 14, 16, 21, 24 and 25 are analyzed as per corresponding method claims 1, 3, 8, 11 and 12 respectively.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 2 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitchen as applied to claim 1.

Claim 2 and 15. The system of claim 1 further including a database integral to said bill processing server for correlating said at least one client billing account stored in said bill payment instructions with a unique alphanumeric identifier assigned to said client and stored in said bill processing server, wherein said client is identified by said bill processing server when said bill payment instructions are received by said bill processing server and wherein and wherein said client confirms said bill payment instructions (col. 6 L 29 - 59, biller data 420a and payor data 420b different portions of the ..bill information are stored ..with a respective identifier of the appropriate payor).

Kitchen fails to disclose that a confirmation message is sent to said client upon identification of said client, and the client confirms bill payment instructions prior to said bill processing server debiting and crediting said client and biller banking accounts respectively .

Art Unit: 3624

Official notice is taken that sending a confirmation message to a payor before affecting the payment according to payment instructions is old and well known.

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate a feature of sending a confirmation message to the client (bill payor) and have the client confirms bill payment instructions prior to affecting the bill payment as claimed because it would assure that the payment is not made inadvertently and that the client verifies that he/she indeed intends to make the payment of the bill which is selected.

8. Claims 4-7, 9, 10, 13, 17-20, 22, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitchen as applied to claim 1 above, and further in view of Remington et al. (US Pat. 6,070,150).

Claims 4-6 and 13. Kitchen fails to disclose, however Remington teaches that bill information is a bill image presentable to said client and said means for formatting said bill information and said bill payment instructions is an HTML form (refer to linkages 226-232 etc. on Fig. 7). The World Wide Web as a network and said server access program as a web browser are discussed (col. 5).

It would have been obvious to one of ordinary skill in the art at the time of invention to format said bill information and said bill payment instructions is an HTML form because it would allow presenting the billing data on the Internet as a web page having links to the host server.

Claim 7. The system of claim 4 wherein said HTML form is contained in an e-mail forwarded by one of said one or more biller servers to a selected one of said at least one client computer (refer to Kitchen col. 7 L 52-60).

Art Unit: 3624

Claim 9. The system of claim 4 wherein the billing image further includes a biller name, a billing account number, an invoice number, an invoice period, details of activity during said invoice period, and a total amount owed for the invoice period (refer to Fig. 11 of Kitchen).

Claim 10. Kitchen or Remington fail to teach that billing image further includes marketing banners and marketing hypertext links to information stored on said one or more biller servers.

Official notice is taken that including marketing banners and advertisement in the form of hypertext links is old and well known.

It would have been obvious to one of ordinary skill in the art at the time of invention to include marketing banners and marketing hypertext links to the billing image because it would allow targeted marketing to the clients closely related to the service providers or merchants.

Claim 13. Kitchen fails to disclose, however Remington teaches communication between said at least one client computer and said bill processing server is in HTML form using SSL 128 bit encryption (col. 15 L 18-40).

It would have been obvious to one of ordinary skill in the art at the time of invention to utilize one of the available encryption techniques to maintain integrity of financial sensitive data communicated over a public network such as the Internet.

System claims 15, 17-20, 22, 23 and 26 are analyzed as per corresponding method claims 2, 4-7, 9, 10 and 13 respectively.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

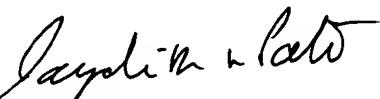
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish

Art Unit: 3624

Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7th Floor, Alexandria VA 22202.



Jagdish N. Patel

(Examiner, AU 3624)

6/10/03